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10/698,480	11/03/2003	Chan-Tung Chen	3624-0136P	3229

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EXAMINER

HUNTER, ALVIN A

ART UNIT PAPER NUMBER

3711

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,480

Applicant(s)

CHEN, CHAN-TUNG

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 requires the perimeter rearward extension bonding to the entire inner surface of the perimeter wall where in claim 7 requires the perimeter extension to include a plurality of notches and teeth wherein the notches allow a portion of the inner surface of the perimeter wall to be exposed. It is not seen how claim 7 is enabled by claim 1 being that claim 1 requires the entire inner surface of the perimeter wall to be covered. Therefore, claims 7 and 8 have been rejected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See the above regarding 112, 1st paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakanishi et al. (USPN 4928972).

Regarding claim 1, Nakanishi et al. discloses a golf club head comprising a golf club head body including a front side and a perimeter wall wherein the perimeter wall extends rearward along the front side of the golf club head body, a striking plate mounted to the front side of the golf club head body wherein the striking plate includes a front face for striking a golf ball and a back, and a reinforcing layer integrally and tightly bonded to the back of the striking plate wherein the reinforcing layer supporting an engaging area between the striking plate and the perimeter wall and the reinforcing layer integrally forms a perimeter rearward extending wherein the perimeter rearward extension extends rearward along an inner surface of the perimeter wall and the perimeter wall being tightly bonded to the entire inner surface of the perimeter wall so as to insure bond attachment of the reinforcing layer to the back of the striking plate while striking the golf ball thereby improving structural strength of the golf club head (See Figures 6 through 8).

Regarding claim 3, Nakanishi et al. discloses the reinforcing layer made of a light material.

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Regarding claim 4, Nakanishi et al. discloses the light material being a carbon fiber resin (See Column 2).

Regarding claim 11, Nakanishi et al. discloses the striking plate integrally formed with the golf club head body as a single member (See Figures 5 and 6).

Claims 1, 3, 4, 6, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Boone (USPN 5540436).

Regarding claim 1, Boone discloses a golf club head comprising a golf club head body including a front side and a perimeter wall wherein the perimeter wall extends rearward along the front side of the golf club head body, a striking plate mounted to the front side of the golf club head body wherein the striking plate includes a front face for striking a golf ball and a back, and a reinforcing layer integrally and tightly bonded to the back of the striking plate wherein the reinforcing layer supporting an engaging area between the striking plate and the perimeter wall and the reinforcing layer integrally forms a perimeter rearward extending wherein the perimeter rearward extension extends rearward along an inner surface of the perimeter wall and the perimeter wall being tightly bonded to the entire inner surface of the perimeter wall so as to insure bond attachment of the reinforcing layer to the back of the striking plate while striking the golf ball thereby improving structural strength of the golf club head (See Figures 16 and 17).

Regarding claim 3, Boone discloses the reinforcing layer made of a light material.

Regarding claim 4, Boone discloses the light material being rubber (See Column 4, lines 10 through 32).

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Regarding claim 6, Boone discloses the back of the striking plate having a main striking area not covered by the reinforcing layer (See Figures 16 and 17).

Regarding claim 11, Boone discloses the striking plate integrally formed with the golf club head body as a single member (See Figures 16 and 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanishi et al. (USPN 4928972).

Regarding claim 9, Nakanishi et al. discloses an embodiment wherein the perimeter wall defines an opening in a back of the golf club head body and a perimeter flange 8 extending from a rear end edge in the inner surface of the perimeter wall for inherently preventing the reinforcing layer and the perimeter rearward extension from disengaging from the opening and well as adjusting the center of gravity (See Figure 5). Nakanishi et al. also notes that the modification such as interchanging various features from various embodiments can be made (See Column 8 lines 1 through 9). One having ordinary skill in the art would have found it obvious to have a flange on the back of the club head body, as taught by Nakanishi et al., in order to secure the reinforcing layer and to also adjust the center of gravity.

Regarding claim 10, It should be noted that the applicant does not disclose why it is critical for the striking plate to be welded, brazed, inserted, pressed, or screwed to the golf club head body if the striking plate can be integrally formed with the golf club head body in order to attain the invention. Nakanishi et al. discloses the striking face being integrally formed with the club head body in which the reinforcing layer is attached to the rear surface thereof. One having ordinary skill in the art would have found the assembly of the striking plate to the club head body to be an obvious matter of design choice. The striking plate being integrally formed with the club head body performs equally as well being that the striking plate provides a place where the golf ball may be struck and provide a backing surface for which the reinforcing layer may be applied.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanishi et al. (USPN 4928972) in view of Nagamoto et al. (USPN 4824116).

Regarding claim 2, Nakanishi et al. discloses the reinforcing layer being formed by pressing but does not explicitly disclose heat pressing. Nakanishi et al. notes that the reinforcing layer is in crude form, meaning that it is in natural form. Nagamoto et al. discloses a club head made of a fiber reinforcing material wherein in order to obtain the desired shape, a crude fiber-reinforced material is heat pressed or injection molded (See Column 2, lines 5 through 9). One having ordinary skill in the art would have found it obvious to heat press or injection mold the reinforcing layer, as taught by Nagamoto et al., in order to obtain the shape desired for the reinforcing layer.

Response to Arguments

Applicant's arguments with respect to claims 1-4 and 6-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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